

## **REMARKS**

Claims 1-9, 19, 20 and 30-35 remain pending in this application. By the present amendments, the previously presented claims have been amended to more particularly point out particularly preferred features of certain embodiments of the claimed invention. No new matter has been introduced by any of these amendments. Support for the amendment to step (c) of claim 1 may be found, for example, in paragraph [45] of the specification.

### **I. Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claims 1-3, 5, 7-9, 19, 20 and 30-35 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. While not acceding to the Examiner's characterization of the prior claim language, solely in an effort to expedite prosecution, Applicants have amended claims 1 and 30 as shown above. In view of these amendments, the outstanding rejection has been obviated and withdrawal thereof is respectfully requested.

### **II. Rejections for Double Patenting**

The Examiner has maintained the rejection of claims 1-9, 19, 20 and 30-35 under the judicially-created doctrine of obviousness-type double patenting over claims 1-24 U.S. Patent Application No. 10/635,010, now U.S. Patent No. 7,211,407, either alone or in combination with Zhang et al. As noted by the Examiner in the outstanding Office Action, Applicants will submit the appropriate terminal disclaimer when allowable subject matter is indicated in this application.

### III. Rejections Under 35 U.S.C. § 103

#### A. Woska in view of Curtis and Zhang

The Examiner has rejected claims 1-3, 5, 7-9, 19, 20 and 30 under 35 U.S.C. § 103(a) as allegedly obvious over Woska, U.S. Patent Publication No. 2002/0068305, in view of Curtis, U.S. Patent Publication No. 2003/0022205 and further in view of Zhang, *Endocrinology* **141(9)**:3514-3517 (2000). Applicants respectfully traverse this rejection.

Even assuming that the Examiner's characterization of the cited references is correct, a point that Applicants do not concede, the cited references do not teach or suggest claim 1 as amended above. That is, as amended, claim 1 requires that the cells be incubated in the presence of a candidate agent for at least 16 hours. There simply is no teaching or suggestion of such a step in the cited references.

More specifically, Woska teaches that incubation should be permitted to continue for only one (1) hour, while Curtis and Zhang are utterly silent on this point. There is no teaching or suggestion in any of these references that incubation should be performed for at least 16 hours. Indeed, if one skilled in the art followed the teachings of the combined references proposed by the Examiner, one would not achieve a successful result with the presently claimed method.

Rather, by incubating the cells for only one (1) hour in the presence of the candidate agent, one skilled in the art would not observe any change in the level of expression of the membrane ion channel. Such would be the result achieved regardless of whether the candidate agent actually changed the level of expression of the membrane ion channel simply because the incubation period was not long enough. Yet there is nothing in any of the references cited by the Examiner that would suggest that the incubation period should be increased from the one (1) hour actually disclosed. There certainly is no

teaching or suggestions that the incubation period should be increased by more than an order of magnitude.

For at least these reasons, withdrawal of the outstanding rejection of claims 1-3, 5, 7-9, 19, 20 and 30 under 35 U.S.C. § 103(a) as allegedly obvious over Woskain view of Curtis and Zhang is respectfully requested.

**B.      Woska in view of Vallone and Zhang**

The Examiner has rejected claims 1-3, 5, 7-9, 19, 20 and 30 under 35 U.S.C. § 103(a) as allegedly obvious over Woska, U.S. Patent Publication No. 2002/0068305, in view of Vallone, U.S. Patent Publication No. 2004/0018566 and further in view of Zhang, *Endocrinology* **141(9)**:3514-3517 (2000). Applicants respectfully traverse this rejection.

As with the rejection above, even assuming that the Examiner's characterization of the cited references is correct, the cited references do not teach or suggest the subject matter of amended claim 1, *i.e.* that the cells be incubated in the presence of a candidate agent for at least 16 hours. There simply is no teaching or suggestion of such a step in any of the cited references, either alone or in combination.

More specifically, as noted above, Woska teaches that incubation should be permitted to continue for only one (1) hour. Both Vallone and Zhang are completely silent as to the time period for incubation. There is simply no teaching or suggestion in any of these references that the incubation should be performed for at least 16 hours. And, as also noted above, if one skilled in the art followed the teachings of the combined references proposed by the Examiner, one would not achieve a successful result with the presently claimed method.

For at least these reasons, withdrawal of the outstanding rejection of claims 1-3, 5, 7-9, 19, 20 and 30 under 35 U.S.C. § 103(a) as allegedly obvious over *Woska* in view of *Vallone* and *Zhang* is respectfully requested.

**C.     *Woska* in view of *Curtis* or *Vallone* and *Zhang* and *Owman***

The Examiner has rejected claims 31-35 under 35 U.S.C. § 103(a) as allegedly obvious over *Woska*, U.S. Patent Publication No. 2002/0068305, in view of *Curtis*, U.S. Patent Publication No. 2003/0022205 or *Vallone*, U.S. Patent Publication No. 2004/0018566, and further in view of *Zhang*, *Endocrinology* **141(9)**:3514-3517 (2000) and still further in view of *Owman*, U.S. Patent Publication No. 2002/0150912. Applicants respectfully traverse this rejection.

The deficiencies of *Woska*, *Curtis*, *Vallone* and *Zhang* have been discussed above. *Owman* does not remedy these deficiencies, *i.e.* *Owman* does not teach or suggest that the cells be incubated in the presence of a candidate agent for at least 16 hours.

For at least these reasons, withdrawal of the outstanding rejection of claims 31-35 under 35 U.S.C. § 103(a) as allegedly obvious over *Woska* in view of *Curtis* or *Vallone* and further in view of *Zhang* and still further in view of *Owman* is respectfully requested.

**IV.    Final Office Action**

Even though the Examiner has just issued a new rejection, based on a newly cited reference (*Curtis*), the Examiner has nevertheless designated the outstanding Office Action as a “final” Office Action. Applicants respectfully traverse the “finality” of the outstanding Office Action and request that, at the very least, this “finality” be withdrawn and prosecution on the merits continued.

More specifically, in justifying the “finality” of the outstanding Office Action, the Examiner has asserted that “Applicant’s amendment necessitated the new grounds of rejection presented in this Office Action.” Applicants note, however, that Applicants’ prior amendment of claim 1 simply incorporated the limitations from original dependent claim 4 and original dependent 6 into independent claim 1. As such, all of the limitations now found in amended claim 1 were already presented to the Examiner in the original dependent claims. Consequently, the Examiner was on notice from the outset of prosecution that Applicants’ claims included the subject matter now found in amended claim 1.

Accordingly, the outstanding rejection should have properly been made, if at all, in the first Office Action on the merits. Having only just newly issued this rejection in the outstanding Office Action, it is improper for the Examiner to designate that Action as a “final” Office Action. Applicants therefore respectfully request that the “finality” of the outstanding Office Action be withdrawn.

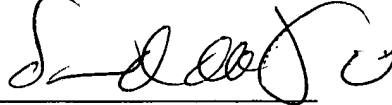
### **CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, Donald R. McPhail, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136(a) is hereby made. Please charge any shortage in fees due in connection this filing, concurrent and future, to Deposit Account No.04-1679.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Donald R. McPhail', written over a horizontal line.

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